REMARKS

Claims 1, 4, 5, 7, 9, 13, 15 to 17, 21, 27 and 33 to 59 are pending in the
application, of which Claims 1, 7 and 13 are independent. Reconsideration and further
examination are respectfully requested.

Claims 1, 4, 5, 7, 9, 11, 13, 15, 16, 21, 27 and 33 to 35 are rejected under 35
U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 7,159,190 (Perry). Claims 5 and 17 are
rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,159,190 and
further in view of Allegedly Admitted Prior Art (AAPA). Claims 15, 21 and 27 are rejected
under 35 U.S.C. § 103(a) as being unpatentable over Perry, and further in view of U.S. Patent No.
6,724,492 (Iwase). Claims 36 to 44 are rejected under 35 U.S.C. § 103(a) as being unpatentable
over Perry and further in view of U.S. Patent No. 6,621,590 (Livingston). Reconsideration and
withdrawal of these rejections are respectfully requested.

The present claims concern setting printer settings by a printer control apparatus
using a setting screen to set a print attribute to be applied to the print data and a partial setting
screen to set a partial print attribute to be applied to a part of the print data. In one aspect, the
printer control apparatus displays a setting screen to set a print attribute to be applied to the print
data and then displays a partial setting screen including (i) a first designation field to set a partial
print attribute to be applied to a part of the print data, and (ii) a second designation field to
designate a page as the part of the print data to which the partial print attribute is applied. Since
an initial value of the first designation field in the partial setting screen indicates that a print
attribute that is the same as the entire print attribute is already set, it is not required that the user
reenter a partial attribute which has the same value as the print setting attribute.

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Turning to specific claim language, independent Claim 1 is directed to a printing control method executed in an information processing apparatus which has a printer driver to generate print data which a printing apparatus can process. The printing control method comprises a first displaying step of displaying screen to set a print attribute of the print data attribute to be applied to the print data, a second displaying step of displaying a partial setting screen including (i) a first designation field to set a partial print attribute to be applied to a part of the print data, (ii) a second designation field to designate a page as the part of the print data to which the partial print attribute is applied, wherein an initial value of the first designation field in the partial setting screen indicates that a print attribute same as the print attribute of the print data is set; and a generating step of generating the print data to print a print material in which the print attribute of the print data and the partial print attribute are reflected.

Applicant submits that Perry fails to disclose or suggest all of the features of Claim 1. In particular, Perry fails to disclose or suggest at least the features of displaying a partial setting screen including (i) a first designation field to set a partial print attribute to be applied to a part of the print data, (ii) a second designation field to designate a page as the part of the print data to which the partial print attribute is applied, wherein an initial value of the first designation field in the partial setting screen indicates that a print attribute same as the print attribute of the print data is set.

In contrast to the present claims, Perry discloses Figs. 6A to 6D that are exemplary displays of a print job exceptions attributes window 406 that can be used to edit print job exceptions attributes. As illustrated in FIG. 6A of Perry, a user can access the second exception page template 317 that allows editing of specific print job exceptions attributes by selecting tabs 318 to 321 on the template 317. The second exception page template 317 can

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include various tabs with labels that identify the print job exceptions attributes for a selected print job identification number or print job name. For example, the second exception page template 317 in FIG. 6A provides tabs that include attributes such as stock 318, output 319, image quality 310 and image edit 321. Fig. 6A illustrates selection of stock tab 318, Fig. 6B, selecting an image quality tab 320, Fig. 6C illustrates selection of an output tab 319, and Fig. 6D illustrates selection of an edit tab 321. (See Perry column 7, lines 18 to 45.)

In the Office Action, it is contended that Figs. 6A to 6D of Perry show the result of processing that is the same as the processing executed in the second displaying step of the present claims. Applicant submits that Figs 6A to 6D simply illustrate a single step of designating various attributes of a print job and do not disclose or suggest a second displaying step as featured in the present claims. Specifically, the cited figures of Perry fail to disclose displaying a partial setting screen including (i) a first designation field to set a partial print attribute to be applied to a part of the print data, (ii) a second designation field to designate a page as the part of the print data to which the partial print attribute is applied, wherein an initial value of the first designation field in the partial setting screen indicates that a print attribute same as the entire print attribute is set. For example, according to Fig 6A of Perry, although "Plain" is displayed as a paper type, it is not disclosed that the value "Plain" is an initial value of the paper type setting. In addition, even if the value "Plain" set as a paper type is an initial value of the setting, it is not disclosed that the value "Plain" is set as the paper type in the entire print setting. Therefore, even if a value such as "Heavy paper" is set as an entire print setting in a system according to Perry, the value "Plain" is still displayed as the initial value of the paper type, as shown in Fig. 6A of Perry.

In the Office Action, at page 3, paragraph c, it is stated that "(i)t is inherent that the exception page template 317 of Fig.6A must display the existing settings for the stock of the entire print job, otherwise the user would be required to manually reenter every attribute even when a change for only one attribute is desired." Applicant respectfully submits that the Office Action does not present a rationale or evidence tending to show that the exception page template 317 of Fig.6A of Perry inherently discloses the features of (i) a first designation field to set a partial print attribute to be applied to a part of the print data, (ii) a second designation field to designate a page as the part of the print data to which the partial print attribute is applied, wherein an initial value of the first designation field in the partial setting screen indicates that a print attribute same as the print attribute of the print data is set.

M.P.E.P. § 2112.IV provides in part that "(t)he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Furthermore, "(t)o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In the Office Action, it is contended that "the exception page template 317 of Fig.6A must display the existing settings." However, the page template 317 of Perry, if it is actually implemented, is no more than a programming construct and creation of a programer. As such, there are no functions, such as displaying existing settings, that necessarily flow from such

an implementation. Instead each function would have to be expressly programmed into the page template by the programmer and any such function may or may not be included at the whim of the programmer. As acknowledged in the Office Action, there is nothing in Perry that discloses or even suggests that the page template 317 includes the feature that an initial value of the first designation field in the partial setting screen indicates that a print attribute same as the print attribute of the print data is set as featured in the claims. Therefore, at best, it is only a possibility that the exception page template 317 of Fig.6A could have been implemented to display the existing settings.

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference. The Office Action merely states that the exception page template 317 of Fig.6A must display the existing settings because "otherwise the user would be required to manually reenter every attribute even when a change for only one attribute is desired." Initially, Applicant notes that there is no necessary relationship between manually reentering or resetting an existing attribute and displaying such an attribute, as one operation can be done without the other. In addition, the claims feature an initial value of the first designation field in the partial setting screen that indicates that a print attribute same as the print attribute of the print data is set. As such, the present claims feature displaying an initial value for an attribute that is being set in the partial setting screen and do not feature management of all of the remaining attributes that may or may not be set for the print data. Therefore, even if it were true that displaying all of the existing settings was necessary to prevent manually reentering every attribute even when a change for only one attribute is desired, such a relationship is not relevant to the present claims.

Accordingly, Applicant submits that the Office Action does not present a rationale or evidence tending to show that the exception page template 317 of Fig.6A of Perry inherently discloses (i) a first designation field to set a partial print attribute to be applied to a part of the print data, (ii) a second designation field to designate a page as the part of the print data to which the partial print attribute is applied, wherein an initial value of the first designation field in the partial setting screen indicates that a print attribute same as the print attribute of the print data is set.

Applicant has reviewed the remaining cited references and submits that nothing in these references supply that which is missing from Perry. In light of the deficiencies of Perry and the remaining cited art, Applicant submits that independent Claim 1 is in condition for allowance and respectfully requests same.

Claims 7, 11 and 13 are directed to an apparatus, a system and a computer-readable storage medium, respectively, substantially in accordance with the method of Claim 1. Accordingly, Applicant submits that Claims 7, 11 and 13 are also in condition for allowance and respectfully request same.

The other pending claims in this application are each dependent from the independent claims discussed above and are therefore believed allowable for at least the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

CONCLUSION

The Director is authorized to charge $936.00 for 18 additional claims fees to

Deposit Account No. 06-1205.

Applicant's undersigned attorney may be reached in our Costa Mesa, CA office at

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Respectfully submitted,

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